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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,753	06/11/2001	Jose-Luis Abad-Peiro	CH919980004U	6136
7590 10/02/2006			EXAMINER	
Ference & Associates 129 Oakhurst Road Pittsburgh, PA 15215			KYLE, CHARLES R	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,753

Applicant(s)

ABAD-PEIRO ET AL.

Examiner

Charles Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 1002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/30/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claims 2 and 17, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claims 4,7 and 13, the word "may" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

As to claims 1-17, they recite various combinations of the phrases "low resource-intensive secure communication protocol", and "highly secure payment protocol". These phrases are vague and indefinite because they recite relative phrasing and one of ordinary skill in the art would not know what constitutes low resource intensiveness or high security. As well, these relative comparisons will change over time and are thus indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,592,375 *Bardwell et al.*

As to Claim 1, *Bardwell* discloses the invention substantially as claimed, including in a computerized method of transacting electronic commerce in an insecure network (see Abstract), the method improving data security in the insecure network by:

- (a) operating on and between a user ('Buyer') which has established a commercial relationship with a certified trusted third party ('Serves', see column 13, lines 61-62), and merchants ('Seller');
- (b) utilizing a network link between the user and the third party and a network link between the third party and the merchants (column 14, lines 20- 34); and
- (c) utilizing a communication protocol which operates on the network link between the user and the third party (obviously present); and
- (d) utilizing a payment protocol, which is more resource intensive than the communication protocol, which operates on the network link between the third party and the merchants (column 1, lines 50-55, in the likely case where both interfaces have two modes, the user has a low-bandwidth communications channel, and the merchant a high-bandwidth communications channel. The fact that two modes are specifically disclosed indicates clearly that there are different protocols involved, and not simply one protocol operating faster or slower).

Bardwell does not state that the high resource intensive protocol is more secure. However, the skilled person will clearly want as much security as is reasonably possible due to the sensitive information being transferred. With the means already in place for choosing the protocol depending on available bandwidth, it would be obvious to implement higher security in

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the second mode protocol where it is known that a higher bandwidth is available. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Bardwell* to use a high resource intensive protocol because this would allow for the transmission of relatively more information related to the securing of transmitted information.

As to Claim 16, as the corresponding computerized method, see the discussion of claim 1.

Claims 2-5, 7, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,592,375 *Bardwell et al* in view of EP A 0 854 462 *Hiroya et al*.

As to Claim 7, *Bardwell* discloses the invention substantially as claimed, including in (particular Figures 1 and 5) a computerized method of enabling a trusted third party (Figure 1, 'Server'), interfacing with users ('Buyers') on an insecure network (column 14, lines 20-34), to offer users the ability to browse and compare information (column 1, lines 19-25) and purchase products, (see column 13, lines 65-67, and Figure 5, steps 570 and 572), the method comprising:

- (a) using a communication protocol (necessarily present), presenting a user with an interface from which the user can browse and request information concerning the products of merchants ('Sellers', column 3, lines 14-24), and compare such information via an interactive window;
- (b) gathering the requested information from the merchants;
- (c) using the communication protocol, providing the requested information to the user via the interactive window (see Figure 5, also column 2, lines 11-14 and column 3, lines 38-47).

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Bardwell does not specifically disclose the fooling details of payment procedure:

- (i) that payment is by means of a secure payment facility, irrespective of the level of security between the user (buyer) and the third party
- (ii) that upon the user's selection of a product offered by a merchant (seller), the user's payment order is received;
- (iii) that payment is transmitted by means of a payment protocol, which is more secure than the communication protocol;
- (iv) that confirmation of payment is transmitted to the third party; and
- (v) that confirmation of payment is transmitted to the user.

As it is not even clear from D1 if the payments themselves are carried out over the network, none of the above can be assumed to be the case.

However, *Hiroya* which describes a system for purchasing products/services over the Internet, does go into more detail concerning how the online payments are carried out. It discloses:

- (i) that payment is by means of a secure payment facility (the 'electronic cash' described in column 1 of D2 clearly has its own security features),
- (ii) that upon the user's (buyer's) selection of a product offered by a merchant (prospective employee), the user's payment order is received (see column 6, lines 35-40);
- (iii) that payment is transmitted by means of a highly secure payment protocol, upon receipt of which the merchant may receive payment (Figure 5, step 6007, whereby the settlement message, containing the (secure) payment, is transmitted to the merchant; see also column 7, lines 16-20);

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There is no mention of the transmission of receipts of payment, merely those of receipts of goods purchased. However, acknowledging payment with a receipt is standard practice, whether carried out on paper or electronically.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Bardwell* to use the detailed payment mechanism of *Hiroya* because this would have provided secure mechanisms to effect a purchase transaction.

As to claims 10 and 13, they represent different perspectives from Claim 7 (user and merchant respectively) but have essentially the same features and are rejected in a like manner.

With reference to claim 2, the fact that the trusted third party of *Bardwell* is a server (see Figure 1), implies that it is built into a housing including a terminal interface. The use of the *Bardwell* system for selling products is suggested (column 2, line 20), and choosing a specific type of product, for example insurance (which does not necessarily require the transfer of a physical entity), which is suitable for online commerce does not amount to an inventive step.

As to claim 3, see *Bardwell* (column 3, lines 28-36; obviously the names 'merchants' and 'users' are arbitrary, and can be interchanged).

As to claims 4 and 5, *Bardwell* discloses the following points, references for which are given: (1) and (3) column 3, lines 37-47, and column 9, lines 30-35 (2) Figure 1, and column 3, lines 19-21 (4) (without payment order) Figure 5, step 570

The references to payment, part of (4), (5) and (6) are not disclosed in *Bardwell*, but are known from *Hiroya* (see above).

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Claims 6, 8-9, 11-12, 14-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,592,375 *Bardwell et al* in view of EP A 0 854 462 *Hiroya et al* and further in view of EP 0 822 535 *Apte* and *Electronic Payment Systems*, hereinafter, *O'Mahony*.

As to **Claims 6, 8-9, 11-12, 14-15 and 17**, they specify the communication protocol and the payment protocol as being the SSL and SET protocols respectively, that the browser is JAVA enabled, and that the interactive window is an applet.

SSL and SET protocols are industry standards, with well known advantages and disadvantages (e.g. level of security offered, processing time required, level of anonymity, etc.). Depending on the exact requirements, these two protocols represent the obvious choices for payment protocols (see *O'Mahony* at pages 101-123 for reference). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Bardwell* to use the protocols disclosed by *O'Mahony* because this would have provided a secure, efficient mechanism for transmission of purchase and payment information, and provide customers assurance of such security.

Similarly, the use of JAVA browsers and applets is also known as a means of providing interactivity over the Internet (see for example, *Apte*, column 6, lines 23-30 and referenced Figures.). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Bardwell* to use the JAVA enabled applets of *Apte* because this would provide functionality at a user (buyer) computer without being permanently stored there.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kyle whose telephone number is (571) 272-6746. The examiner can normally be reached on 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

crk
September 12, 2006


CHARLES R. KYLE
PRIMARY EXAMINER